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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

200309110-1

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on 3/29/06

Signature *Desiree Reardon*

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Application Number

10/699,532

Filed

10/31/2003

First Named Inventor

Carlos Alberto Bonilla

Art Unit

2863

Examiner

Aditya S. Bhat

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ attorney or agent of record.      35,398  
Registration number \_\_\_\_\_
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Remarks Accompanying Pre-Appeal Brief Request For Review

In response to the final Office Action dated December 30, 2005, Applicants respectfully request a review of the final rejection in the above-identified application. Applicants respectfully submit that the Examiner's rejections of Claims 1-22 under 35 USC 102 (a, e) is improper. MPEP 706.02(a) clearly states that once the Examiner conducts a search and finds a ..., the Examiner should determine whether the rejection should be made under 35USC 102(a), (b) or (e) (emphasis added). Clearly, the Examiner did not perform the determining. Additionally, Applicants respectfully submit that the Examiner's rejection of the Claims 1-22 under the improper 35 USC 102(a, e) as being anticipated by Hsieh et al (2003/0093283) is improper as an essential element needed for a proper prima facie rejections is missing (e.g., the teaching of all of the recited claim limitations).

Rejection Under 35 USC 102(a, e)

KEY CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED REFERENCES

Claim 1 (Claims 8 and 15 contain similar features) sets forth a method of managing a testing task, said method comprising:

receiving a plurality of test cases to run, each test case including a plurality of requirements for running said respective test case;

receiving an identification of a group of available test systems on which to run said test cases;

for each test case, determining a list of applicable test systems from said group that satisfy said requirements of said respective test case;

automatically selecting and starting test cases to run based on each respective list and said available test systems so that as many test cases as possible are run in parallel; and

when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems.

**According to the Federal Circuit, "[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration" (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the**

**Federal Circuit, the prior art reference must disclose each element of the claimed invention “arranged as in the claims” ( Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)).**

In the current Office Action, the Examiner makes reference to Hsieh et al. in supporting the grounds of rejection. However, Applicants do not understand Hsieh to teach the claimed feature “when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems.” On page 3 of the Office Action mailed 12/30/05, the Examiner has cited page 1 paragraph 14 of Hsieh et al. as providing the anticipation for the claimed feature.

Applicants disagree that this section of Hsieh et al. anticipates or even mentions the claimed feature. Applicants understand page 1 paragraph 14 of Hsieh et al. to anticipate the provision of testing files and associated data files to be centrally managed by a file server, so that they can be easily updated. Applicants do not understand central management to anticipate “automatically selecting and starting an additional test case.” For this reason, Applicants respectfully state that Hsieh et al. does not anticipate the features of simulation as claimed in Independent Claims 1, 8 and 15 and as such the rejection under 35USC102(a,e) is improper and should be reversed.

In addition, Applicants respectfully understand Hsieh et al. to teach and anticipate in the first paragraph of the summary of the invention a convenient and cost-effective testing procedure that can be completed in one pass at a single test site without having to undergo a number of test sites. Therefore, Applicants respectfully assert that if Hsieh et al. teaches a testing procedure completed in one pass, that does not anticipate the claimed feature ““when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems.” For this additional reason, Applicants respectfully state that Hsieh et al. does not anticipate the features of simulation as claimed in Independent Claims 1, 8 and 15 and as such the rejection under 35USC102(a,e) is improper and should be reversed.

Furthermore, Applicants respectfully understand Hsieh et al. to teach that the one pass testing steps are carried out automatically, but that the administrator forwards the test-procedure. This teaching by Hsieh et al. is directly opposite to the claimed feature

“automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems.” That is, if an administrator is selecting and forwarding the test procedure, then the additional test case is not automatically selected and started (emphasis added). For this reason, Applicants respectfully state that Hsieh et al. does not anticipate the features of simulation as claimed in Independent Claims 1, 8 and 15 and as such the rejection under 35USC102(a,e) is improper and should be reversed.

Additional arguments provided on pages 7-9 of the response to the Non-Final Office Action mailed June 2, 2005 are also referenced as evidence that Hsieh et al. does not anticipate the claimed features. For this further reason Applicants respectfully state that Hsieh et al. does not anticipate the features of simulation as claimed in Independent Claims 1, 8 and 15 and as such the rejection under 35USC102(a,e) is improper and should be reversed

Regarding The Examiner's Response To Argument On Page 5 Second Paragraph of the final Office Action mailed 12/30/2005

The Examiner has stated “paragraph 13 (of Hsieh et al.) discusses an overall testing procedure that does not require a test engineer to select and swap required disks in and out of the computer unit being tested. Each swap of a disk could constitute a new test, however since the procedure is done automatically the claims are believed to read on the claimed invention.”

Applicants respectfully agree with the Examiner's initial statement of Hsieh et al. but disagree with the Examiner's logical conclusion. First, Applicants agree and understand Hsieh et al. to discuss an overall testing procedure that does not require a test engineer to select and swap required disks in and out of the computer unit being tested.

However, Applicants do not agree with the conclusion. The Examiner states that “each swap of a disk could constitute a new test, however, since the procedure is done automatically the claims are believed to read on the claimed invention. Specifically, Applicants do not understand Hsieh et al. to teach a procedure for automatically selecting an swapping required disks in and out of the computer unit being tested. Moreover, Applicants do not understand the present Claims 1-22 to feature any type of device that can automatically select and swap a disk in and out of the computer unit being tested.

For this additional reason, Applicants respectfully state that Hsieh et al. does not anticipate the features of simulation as claimed in Independent Claims 1, 8 and 15 and as such the rejection under 35USC102(a,e) is improper and should be reversed

In summary, Applicants respectfully submit that the Examiner's rejections of the Claims are improper as key limitations needed for proper prima facie rejections of Applicants' Claims are not met by the cited reference as outlined above. Moreover, because key limitations of independent Claims 1, 8 and 15 (from which Claims 2-7, 9-14 and 16-22 pend ) are not anticipated by Hsieh et al., Applicants respectfully submit that the rejection of Claims 1-22 under 35 USC 102(a,e) as being anticipated by Hsieh et al. is improper and should be reversed.